

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Xdrive, Inc.

Inventor(s): **O'BRIEN et al.**

Serial Number: Filed herewith

Examiner: tbd

Filed: Filed herewith

Art Unit: Tbd

For: **SHARED INTERNET STORAGE RESOURCE, USER INTERFACE
SYSTEM, AND METHOD**

BOX PATENT APPLICATION

Commissioner for Patents

Washington, D.C. 20231

PRELIMINARY AMENDMENT RESPONSIVE TO OFFICE ACTION DATED 1/26/01

Dear Sir:

This Preliminary Amendment is filed with the continuation application for which U.S. Patent Application Serial No. 09/570,583 filed May 12, 2000 for a Shared Internet Storage Resource, User Interface System, and Method is the parent application. This Preliminary Amendment is responsive to the Office action dated January 26, 2001, an unnumbered paper, Applicant respectfully requests the above-identified utility patent application be reconsidered in light of the Applicant's Remarks below.

In the Claims:

Kindly cancel claim 50 without prejudice as claim 50 has been previously allowed.

Please amend Claim 17 to read as follows. According to 37 C.F.R. § 1.121(c)(1)(ii), the amended claims below are submitted in clean form and separate pages are submitted herewith with the changes marked in a distinct and recognizable fashion.

17. The shared computer network storage system of claim 1 wherein said server further comprises:

a transaction processor, said transaction processor on a non-routable network, said transaction processor guarantees access to and transactions on said first and second databases;

an enterprise java bean cluster (EJBC) on a non-routable network, said enterprise java bean cluster (EJBC) coupled to said transaction processor and handling business logic and resource access methods as well as memory caching for common resources;

an application network on a non-routable network, said application network coupled to said enterprise java bean cluster, said application network including a java application cluster and handling display functions and resource requests;

a web server, said web server coupled to said application network and handling all requests for static content and proxies requests for dynamic content;

a load balancer, said load balancer coupled to said web server and proxying requests to a sub-server having the highest degree of availability or functionality; and

a DNS redirector, said DNS redirector coupled to said load balancer and proxying requests to a resource having a highest degree of functionality.

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REMARKS

This Preliminary Amendment is promptly filed to place the above-referenced case in condition for immediate allowance. Claim 50 has been cancelled, as it has been previously allowed. No claims have been amended. No claims have been added. Claims 1-49 are outstanding in the application.

No new matter has been added to the application, nor has the application been subject to any narrowing amendments.

The Examiner previously rejected claims 1 - 50 under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The Examiner made specific indication of claims 17 and 50, but did not indicate how the remaining claims were indefinite. Claim 50 has been cancelled. Consequently, Applicant believes that claim 17 is sufficiently definite in order to particularly point out and distinctly claim the subject matter Applicant regards as the invention. Claim 17 has been amended in order to address the Examiner's rejection by resolving a typographical error. Consequently, the rejection of claim 17 based on 35 U.S.C. § 112 second paragraph is believed to be overcome.

The Examiner also rejected claims 1 - 49 under 35 U.S.C. § 102(e) as being anticipated by Carter et al., U.S. Patent No. 5,987,506 issued November 16, 1999 for Remote

Access and Geographically Distributed Computers In a Globally-Addressable Storage Environment.

In rejecting claim 1, the Examiner indicated that Carter teaches a shared computer network system comprising the elements set forth in Applicant's claim 1. In indicating that the Carter '506 patent comprises a first database containing filed data, the Examiner made reference to Figure 5, element 220 of the Carter patent.

Element 220 of Figure 5 is a shared memory subsystem 220, and no reference is made with respect to element 220 as to its being a database. Enclosed with the Examiner's reference and to be made of record as Exhibit 1 are definitions of databases indicating that some structure or form must be present in order for the database to function as something beyond a mere collection of data elements such as files. The Carter '506 patent does not disclose a database containing file data. It discloses a collection of data files, but these do not meet the criteria for being organized sufficiently in order to become a database.

The Examiner also indicated that the Carter '506 patent comprised a second database containing information (metadata) about said file data of said first database referring to Figure 5, element 222. Element 222 in Figure 5 is a virtual shared memory system as indicated in column 18, lines 44-62. As for the file data database, this metadatabase is not given any particular structure and does not rise to the level of being a database. There is no structure to the metadatabase in the Carter '506 patent. Nor is there any separation or coordination of the second database beyond that of the file collection set forth in the Carter '506 patent.

Applicant's disclosure indicates that having a metadata database is a significantly advantageous element as indicated on page 16, line 23 and continuing on to the next page. Specifically, the use of the databases 152 separate from the actual files provides very quick and

easy means by which user requests can be satisfied. No such advantage is seen in the Carter et al. '506 patent, which is meant to provide file sharing between "clouds" being defined as communicating computer networks (Carter et al. '506, column 28, line 61 et seq.).

Consequently, as the Carter et al. '506 patent does not disclose either a first or second database containing, respectively, file data and metadata about the files, the Carter et al. '506 patent does not anticipate nor does it make obvious Applicant's claim 1.

As claims 2 - 19 all depend upon claim 1, these claims are also patentable over the Carter et al. '506 patent as they enjoy the same patentable character as claim 1.

The same is similarly true for the Examiner's rejection in paragraph 24 of the Office action of claims 20, 34, 38, 43, and 44. In rejecting these claims, the Examiner refers to the same memory elements of Figure 5, elements 220 and 222, with regards to first and second databases. As set forth above, the Examiner's indications are not to databases but to memory devices. Memory devices are not databases, as databases are at least intentionally-structured collections of data. As set forth above, there is no such structure in the Examiner's alleged databases. Consequently, Applicant believes that claims 20, 34, 38, 43, and 44 are neither anticipated nor made obvious by the Carter et al. '506 patent, either alone or taken in any reasonable combination with the prior art.

Accordingly, Applicant believes that claims 21, 22, 35 - 37, 39 - 42, and 45 - 49 are all patentable over the Carter et al. '506 patent as these claims depend on one of these above-listed claims that were rejected by the Examiner in paragraph 24 of the underlying Office action of January 26, 2001.

The Examiner rejected claim 23 in indicating that the Carter et al. '506 patent teaches a method for providing private file space and information transfer over a public network,

including a number of different elements allegedly corresponding to Applicant's claim 23.

The Examiner relied on element 218 of Figure 5 of the Carter et al. '506 patent for Applicant's publicly available private file space system coupled to a public computer network. However, the Carter et al. '506 patent indicates that element 218 is an optional private memory device that is explained in more detail in column 19, line 5 et seq. In that passage, the private memory provides the node with local storage that can be kept inaccessible to other nodes on the network. As the private memory device 218 can be kept inaccessible to other nodes on the network, it cannot be a part of a publicly available file space system whether or not it is private. Consequently, the private memory device 218 cannot meet the criteria necessary for an element in Applicant's claim 23 as while private memory device 218 may provide private file space, it cannot be publicly available as it can be kept inaccessible to other nodes of the network. If the private memory device 218 is inaccessible to other nodes on the network, it is not publicly available.

Consequently, Applicant believes that claim 23 is patentable over the Carter et al. '506 patent, either alone or taken in conjunction in any reasonable combination with the prior art.

Additionally, claims 24 - 25 are likewise to be patentable over the Carter et al. '506 patent as they depend upon claim 23.

The same is similarly true for claim 28, which the Examiner rejected in a manner similar to that as for claim 23. In relying upon element 218 of Figure 5, the private memory device 218 is not consistent with and therefore cannot anticipate or make obvious Applicant's publicly available private file space system as set forth with respect to claim 23.

The Examiner rejected claims 29 - 33 under the Carter '506 patent, as the Examiner indicated that the Carter '506 patent teaches the data structure for effecting file operations on a

private file space and information transfer system over a public network. The arguments with respect to claims 23 and 28 are incorporated herein and summarized, in that the Carter '506 patent does not teach a private file space and information transfer system over a public computer network as element 218 is a private memory device that can be kept inaccessible to the other nodes on the network. This inaccessibility defeats the public nature of the public computer network as set forth in Applicant's claim. Additionally, while the file space must be maintained private in order to ensure privacy, all of the hardware elements of the system in Applicant's claims must be accessible in order to provide network-wide accessibility. If certain hardware elements, such as a private memory element, even though it acts as a private file space system, is unavailable to the remaining part of a network, the utility and accessibility present in Applicant's invention is diminished or possibly defeated. Consequently, the Carter et al. '506 patent does not provide a publicly available private file space system but a privately available file space system that is outside the scope of Applicant's claims.

Applicant is uncertain as to what the Examiner considers to be the elements (as set forth in paragraph 44 of the Office action) that constitute inter alia a user data object, a process request object, a recovery object and the like in the list set forth by the Examiner. In inspecting the references to the Carter et al. '506 patent, Applicant remains uncertain as to how the Examiner has applied the elements of the Carter '506 patent to Applicant's claim. Applicant consequently believes that there is no substantive ground upon which the rejection to claims 29 - 33 are rejected under the Carter et al. '506 patent either alone or taken into any reasonable combination with the prior art. For these reasons, Applicant believes that the rejections to claims 29 - 33 are overcome. Mention is made here that the elements in Applicant's claim derive their meaning and substance from the supporting disclosure set forth

in Applicant's application. To divorce Applicant's claims, the elements thereof, and the specific claim language from the underlying disclosure is believed not to fall within proper claim examination. For these and other reasons, Applicant believes that claims 29 – 33 are allowable over the prior art.

As set forth above, Applicant has rebutted the rejections set forth by the Examiner with respect to the claims rejected under 35 U.S.C. § 102(3) as being anticipated by the Carter et al. '506 patent. Applicant believes that none of the claims are anticipated by the disclosure made by the Carter '506 patent, nor are any of the claims made obvious by taking the Carter '506 patent in any reasonable combination with any other prior art disclosure. Additionally, there is no teaching in any of the other prior art references, including the Carter et al. '506 patent that would lead the person of ordinary skill in the art to Applicant's invention as claimed.

The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the present case, there is no disclosure or suggestion in any of the references relied on by the Examiner from which the Shared Internet System claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner has been unable to reconstruct from the cited references a system which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and
- (2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicant. None of the references, alone or in combination, disclose or suggest the combination of elements recited in Applicant's present claims. As such, Applicant's claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

The subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entirety, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. § 103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the references made of record and the references relied upon by the Examiner in the rejections. The claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). No piecemeal construction of the prior art in view of the Applicant's own disclosure can be pursued in order to negate an applicant's claimed invention. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art . . . "

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in the Carter et al. '506 patent references relied on by the Examiner or the other cited references from which the invention claimed by Applicant can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports

selection and use of the various elements in particular claimed combination. . . . It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

From the foregoing remarks, Applicant's claims are all believed to be patentable over the cited prior art taken singly or in any reasonable combination.

In view of the above, the Examiner is respectfully requested to reconsider his position in view of the remarks made herein and the structural distinctions now set forth. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

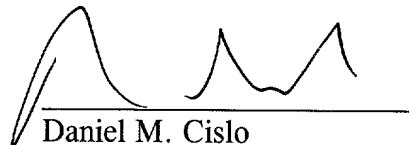
With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicant respectfully requests the Examiner to pass the application on to allowance. It is not believed that any additional fees are due; however, in the event any

additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit
Account No. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Date: February 11th, 2002


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Enclosure

Marked-Up Claims per 37 C.F.R. § 1.121

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O'BRIEN et al.

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For: SHARED INTERNET STORAGE RESOURCE, USER INTERFACE
 SYSTEM, AND METHOD

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**MARKED-UP CHANGES ACCOMPANYING
PRELIMINARY AMENDMENT RESPONSIVE TO
OFFICE ACTION DATED 1/26/01**

Dear Sir:

Accompanying the enclosed Preliminary Amendment and responsive to the Office Action dated January 26, 2001 for the underlying application, Applicant submits herewith the changes made in the accompanying and corresponding Preliminary Amendment, said changes marked in a distinct and recognizable fashion.

In the Claims:

The indicated changes to the claims are made in conformance with and according to 37 C.F.R. § 1.121(c)(1)(ii). The amended claim set forth in the accompanying Preliminary Amendment is Claim 17.

17. (amended) The shared computer network storage system of claim 1 wherein said
server further comprises:

a transaction processor, said transaction processor on a non-routable
network, said transaction processor guarantees access to and transactions on said
first and second databases;

an enterprise java bean cluster (EJBC) on a non-routable network, said
enterprise java bean cluster (EJBC) coupled to said transaction processor and
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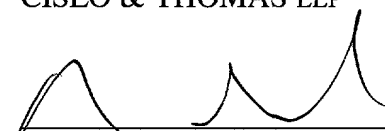
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Respectfully submitted,

CISLO & THOMAS LLP

Date: January 11th, 2002


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